

Patent 09/690,002;
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REMARKS

Reconsideration and allowance of the above referenced application are respectfully requested. Applicant selects the option to reopen prosecution, in order to amend claims 1 and 23, and to cancel claim 22 in order to focus the issues on appeal.

The non-patent literature on the IDS paper number 2 was in fact submitted with the IDS as originally filed. A duplicate copy of this will be submitted if it is still within the files of the undersigned.

Claims 14-16 stand rejected as allegedly being directed to non-statutory subject matter. This contention is respectfully traversed. The program is objected as not being a physical thing. However, the program as claimed clearly is not a disembodied sequence of events. Rather, claim 14 defines a display, and a plurality of controls. The controls allow selecting emails from the display, and allow certain operations on those emails. This sequence of events clearly interacts with the real world. It also controls deleting emails, and as such changes something from one state to another. As such, this is a statutory claim under 35 USC 101.

Claim 22 stands rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite. Claim 22 is canceled to obviate this rejection.

Claims 1-6, 14 and 20, 23-24 stand rejected under 35 U.S.C. 102(b) as allegedly being unpatentable over Pang. This contention is respectfully traversed for reasons set forth herein, and it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a prima facie showing of unpatentability.

Initially, claims 1 and 23 have been amended to obviate the interpretation that these claims could read on a system which has "any of" the claimed elements.

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Moreover, the contention that "delete as not spam", as set forth in various claims is inherent in the prior art is respectfully traversed. The prior art does not disclose any functionality of deleting, while indicating that a message is NOT SPAM. It may delete without indicating whether message is or is not spam, but does not delete while indicating that the message is not spam.

Specifically, Pang teaches a system which enables identifying spam messages to be removed, as noted in its specification. However, Pang does not define displaying information about the message in a way that allows three different ways of deleting (and, as amended, must have all three): 1) without indicating whether it is spam or not; 2) while indicating that it is spam or 3) while indicating that it is not spam, quoting from claim 1. Pang teaches a system where a message can be deleted as being spam. However, there appears to be no way to delete the message while indicating that it is not spam. The cited sections within Pang are illustrative. For example, column 7 line 43 through column 9 line 22 explains that the "no spam" button enables removing the e-mail message and carrying out certain other actions. Nowhere, however, is there any teaching or suggestion of not only a delete as spam button, but also a delete without indicating, and a delete-as-not-spam, as required by the claim. Simply having a delete as spam button does not suggest these other parts. Therefore, claim 1 should be allowable along with the claims that depend therefrom.

Claim 14 should be allowable for analogous reasons. Nowhere does Pang in any way teach or suggest the two claimed controls – one which enables deleting while indicating that the e-mail is spam, and the other which deletes the e-mail "while indicating that said e-mail is not spam".

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Claim 21 and 23 should each be allowable for again for analogous reasons.

Claim 1 is rejected under 35 U.S.C. 102 was allegedly being unpatentable over Paul. This contention is respectfully traversed, and for reasons set forth herein, it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a prima facie showing of unpatentability.

Claim 1 requires receiving an e-mail message, and displaying information about the message in a way that allows deleting the message without indicating whether it is spam or not, deleting the message while indicating that it is spam, or deleting the message while indicating that it is not spam. That is, claim 1 requires these three different options for displaying information about deleting the message. Paul, however, does not teach or suggest these three different options. Admittedly, Paul discloses a heuristic filtering system (see generally column 4 lines 13-28) that attempts to classify whether the message represents spam. The e-mail is displayed along with a suggested display code that was created from the heuristic filters. Therefore, the email is displayed along with the system's recommendation about whether the email represents junk.

The marking as junk is done by Paul based on the contents of the heuristic filters. For example, see Figure 4 which shows performing heuristic processing, and based on that heuristic processing, at 420, mark the e-mail as junk. The same thing is shown in Figures 4A, and Figure 6. There is also an inclusion list filtering in Figure 6.

The user can modify the "inclusion list", which sets more data about which e-mails are marked as junk. See generally column 5 lines 33-37. Note however that the filter is what accesses, modifies and characterizes the e-mail messages; see generally

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the specification column 6 lines 48-50 and 55. The embodiment of Figure 3, similarly performs filtering to determine if the e-mail is junk. See column 7 lines 36-40. Figures 4, 4A and the others are all similar. It is, unlike the present system that displays information "in the way that allows at least one of deleting the message without indicating whether it is spam or not, deleting the message while indicating that it is spam, or deleting the message while indicating that it is not spam", Paul teaches annotating the message with a portion indicating whether it is likely spam. Displaying whether a message is spam is entirely different than allowing deleting the message in one of these three ways noted above.

Referring to the portions noted in the specification, the rejection alleges that the three forms of deleting include certain display codes. None of these codes indicate that the message is to be deleted in certain ways as claimed. Moreover, with all due respect, a display code does not disclose a way of deleting an e-mail.

The rejection refers to clauses in claim 1. These clauses refer to the way that the e-mail is marked with a display code for display to the user. For example, if the message is of interest to the user, it is marked with a second display code and displayed in a second display format. The way that the messages are displayed says nothing about "deleting the message" as claimed.

In the response to argument, the rejection states that it is submitted that e-mail deleting functionality is inherent in all e-mail systems...". However, this is entirely beside the point. Paul classifies e-mails into different categories of junk or not junk. According to the rejection, when the end-users delete the e-mail using the conventional delete button, they are removing it and moving it to the e-mail filter. Somehow, this is

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alleged to be the same as what is being claimed by claim 1. This is quite incorrect. In fact, this line of reasoning would lead to the conclusion that there is only one delete function in Paul, the "conventional" delete function.

Quite simply, this reads functionality into Paul which was never even wildly contemplated by Paul and is certainly not disclosed thereby. Paul discloses nothing about deleting e-mails. Even if it is true that all e-mail systems must have a delete function (something which was never really contemplated by Paul) it certainly does not disclose the specific claimed subject matter which requires displaying information in a way that allows 1) deleting the message without indicating whether it is spam or not, 2) "deleting the message while indicating that it is spam" or 3) "deleting the message while indicating that it is not spam". Nothing in Paul discloses anything other than displaying probable spam indications. The rejection is trying to read 1-3 above into a system that, by the rejection's own admission, never even CONTEMPLATED deleting. Paul discloses nothing about displaying instructions which would enable deleting messages in this way. All of the limitations of claim 1 are clearly not found in Paul, therefore, and therefore claim 1 should be allowable thereover.

Claims 14, 16 and 23-24

These claims are all rejected as allegedly being anticipated by Nielsen. Nielsen teaches a system which allows a function to "delete as junk mail". There is also a function to just delete the message, without indicating whether it is junk mail or not. See Figure 4b which has two options: "delete as junk mail"(425) and "delete message" (427).

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Note that this recites and shows only two different ways of deleting the email, either deleting it as junk mail (425) or just deleting it (427). When the recipient deletes as junk mail, the Figure 10 process is invoked, see generally column 11 lines 49-51, to learn from the junk mail. When the user just plain deletes, no process is invoked. Nothing is learned from the "delete message". The user simply has not indicated whether the e-mail is junk mail or not.

Claim 14 allows the system to learn from either known junk mails or known non-junk mails. Nielsen has no disclosure of such.

This means, therefore, that Nielsen either 1) deletes as junk mail, or 2) deletes, but does not indicate whether it is junk mail or not. Claim 14, on the other hand, allows two controls, one of which indicates that it is junk mail (like 425 in Nielsen) and the other of which deletes the e-mail while "indicating that said e-mail is not spam". This allows learning characteristics of e-mails which are NOT spam. Nowhere does Nielsen meet this latter function. As extensively described above, 427 just deletes the message, it does not indicate that the message is not spam; it simply does not indicate either way.

The rejection states that if the prior art structure is capable of performing the intended use, then it meets the claim. This broad statement, out of context, means nothing. If this statement were true, then no software patent could ever be issued, because the first computer patent would be capable of carrying out any intended use that could later be claimed. Moreover, Nielsen provides no indication that it is even capable of performing the intended use. The rejection is reading much more into Nielsen than is actually disclosed.

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A previous action stated that "the examiner is having a difficult time understanding the functionality differences between "delete an e-mail while indicating that said e-mail is not spam" in the claimed invention, and the delete control of Nielsen allowing the users to delete their e-mails as not spam in Nielsen's teachings". Quite simply, this reads more into Nielsen than is really disclosed. Nielsen's delete message button does not indicate that the message is not spam, it simply indicates that the user has not decided whether the message is spam or not. Nielsen never teaches a delete as not junk mail button. He only teaches a 'delete without deciding' button.

Claim 16

Claim 16 further adds a third control that allows deleting without indicating, or not indicating, whether the e-mail represents "spam". That is, claim 16 defines three different options 1) to delete as spam, 2) delete as not spam or 3) delete without indicating whether or not it is spam. Figure 4b of Nielsen shows two different options, nothing in Nielsen discloses a third option. Clearly claim 16 is not anticipated by Nielsen.

Claim 23

Claim 23 requires a user interface that allows selection to any of:

- A) delete the message without indicating whether or not it represents spam,
- B) delete the message while indicating that it does indicate spam,
- C) delete the message while indicating that it does not indicate spam.

Nielsen does not disclose this. Nielsen only discloses the two options to delete

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as junk mail (425) and delete message (427) without indicating whether it is junk mail or not.

Rejections Under Section 103

Claims 2-7 and 21.

Claims 2-7 and 21 are rejected based on Paul in view of McCormick. Claims 2-7 depend from claim 1 and should be allowable by virtue of their dependency on claim 1. Nothing in McCormick teaches or suggests displaying information which enables deleting the e-mail message in at least one of three different ways as claimed.

Claim 7

Claims 7 requires that the "fields", specifically the fields which are analyzed to determine whether the message is spam, include links within the e-mail message. Analyzing links is nowhere taught or suggested by Paul in view of McCormick and should be independently allowable.

Claim 21

Claim 21 defines forming a numerical score of the incoming message by comparing the incoming message with a list, determining commonalities, and defining the message as being likely unwanted if the numerical score is within a predetermined range.

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Paul teaches filtering messages based on an inclusion list and characteristic criteria, see the top of column 9. The inclusion/exclusion list is described beginning at column 3 line 54. It determines whether categories are found or not. There is no teaching or suggestion of a numerical score in Paul. The rejection alleges that McCormick teaches a numerical score, referring to column 8 lines 48-65. This portion, however, simply refers to a number of users submitting the same e-mail to a collaborative filter. When the multiple users send that same e-mail, then the collaborative filter decides that the e-mail is spam and starts filtering it. It does not require source filtering of e-mail header addresses and the like. Rather, it just filters the messages based on the number of times users have indicated that the specific message is spam. Nowhere is there any teaching or suggestion of a numerical score, as claimed.

Note that claim 21 requires forming a numerical score by comparing the incoming message with the list and determining commonalities between the incoming message and the list. McCormick does not teach or suggest a numerical score of this type. Nowhere is there any teaching or suggestion in McCormick of a numerical score, formed from comparing the message with the list, as claimed. the cited prior art.

Claim 15 was rejected over Nielsen in view of Leeds. Claim 15 requires a weighted scale. However, claim 15 should be allowable by virtue of its dependency.

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In summary of the above, the Patent Office has failed to meet their burden of providing a prima facie showing of unpatentability. For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Therefore, and in view of the above amendments and remarks, all of the claims should be in condition for allowance. A formal notice to that effect is respectfully solicited.

Please charge any fees due in connection with this response to Deposit Account No. 50-1387.

Respectfully submitted,

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